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**OFFICE OF PETITIONS**

In re Patent No. 6,505,391 :  
Philippe Berna :  
Issue Date: January 14, 2003 : DECISION ON  
Application No. 08/580,493 : PETITION UNDER § 1.183  
Filed: December 29, 1995 :  
Title: PROCESS FOR MAKING A :  
VERSATILE CLAMPING DEVICE :  
DESIGNED TO HOLD OBJECTS :  
WITHOUT DAMAGING THEM, SUCH A :  
DEVICE AND ITS USE :

This is in response to the "PETITION FOR SUSPENSION OF THE RULES WHICH WOULD CONFER RETROACTIVITY (PRIOR TO JUNE 8, 1995) AND DISCRIMINATIVE FORCE TO URAA BY OVER-INTERPRETATION," filed July 14, 2003. Receipt of the status inquiry filed June 16, 2004, is acknowledged.

The petition is **DISMISSED**.

Patentee is given **TWO (2) MONTHS** from the mail date of this decision to respond. This period is not extendable. See 37 CFR § 1.181(f).

For the reasons set forth herein, patentee is advised that the patent is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2). In addition, subject to any disclaimer, the twenty year term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 19 days for examination delay.

**BACKGROUND**

Patentee requests that U.S. Patent No. 6,505,391 be given a term of 17 years from date of issuance, and as such, not expire until January 10, 2020. Specifically, patentee petitions:

the Commissioner with deference to suspend the rules, which give Public Law 103-465 (URAA) a retroactive force and a discriminatory force and accordingly to make understandable

on its front page, that patent 6,505,391 has a term of 17 years from grant.

On March 8, 1991, patentee filed application No. 08/580,493. Application No. 08/580,493 is a continuation of application No. 08/321,589, filed on October 12, 1994 (now abandoned), which is a continuation of application No. 07/938,211, filed as application No. PCT/FR91/00190 on March 8, 1991 (now abandoned). The subject patent No. 6,505,391 issued from a continued prosecution application filed August 23, 2001.

#### RELEVANT STATUTES AND REGULATIONS

##### 35 U.S.C. 154(a)(2)

TERM -Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

##### 35 U.S.C. 154(c)(1)

DETERMINATION. -The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

##### As stated in MPEP

All patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the "twenty-year term<sup>1</sup>" or seventeen years from the patent grant. See 35 U.S.C. 154(c). A patent granted on an international application filed before June 8, 1995, and which entered the national stage under 35 U.S.C. 371 before, on or after June 8, 1995, will have a term that is the greater of seventeen years from the date of grant or twenty years from the international filing date or any earlier filing date relied upon under 35 U.S.C. 120, 121 or 365(c). The terms of these patents are subject to reduction by any applicable terminal disclaimers ...

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<sup>1</sup> The term of a patent (other than a design patent) begins on the date the patent issues and ends on the date that is twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), twenty years from the filing date of the earliest of such application(s). This patent term provision is referred to as the "twenty-year term."

### DISCUSSION

U.S. Patent No. 6,505,391 properly has a term beginning on January 14, 2003, the date of issuance of the patent, and ending 20 years after the earliest effective filing date claimed by applicant (section 120, 121, or 365(c) of this title)

Effective June 8, 1995, Public Law 103-465 amended 35 U.S.C. 154 to change the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. The 20-year patent term applies to all utility and plant patents issued on applications filed on or after June 8, 1995.

As to applications filed before June 8, 1995, Transition Patent Term applies. Specifically, patents in force on June 8, 1995, or that result from an application filed before June 8, 1995, will have a patent term that lasts the longer of 17 years from grant or 20 years from filing date.

However, 35 U.S.C. 154 was again amended effective May 29, 2000, and, 37 CFR 1.702-1.705 applies to utility and plant patent applications filed on or after May 29, 2000, and patents issued on such applications. See 37 CFR 1.702(f).

Moreover, the Office treats a continued prosecution application (CPA) as continued examination of the same application, but it is technically and legally a new application. Since a CPA filed under 37 CFR 1.53(d) is a new (continuing) application, a CPA filed on or after May 29, 2000, (and before the end of CPA practice, effective July 14, 2003) is entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. 154(b) and 37 CFR 1.702 through 1.705, regardless of the filing date of any prior application of the CPA. Furthermore, a patent issuing on a CPA is not entitled to any patent term adjustment accumulated during prosecution of any prior application of the CPA.

Applicants were so advised. Nonetheless, it is undisputed that on August 16, 2001<sup>2</sup>, patentee filed a CPA. Patentee argues that revised 154(b) should not apply to this application. Petitioner states that at the time patent 6,505,391 was applied for on March 8, 1991, through the PCT, the U.S. Patent law was 17 years from the earliest filing date. However, the instant application, 08/580,493, is not a national stage entry of a PCT application. Rather, the instant application is a continuation of application No. 08/321,589 (now abandoned), which is a continuation of 07/938,211, which is a national stage entry of PCT/FR91/00190, international filing date March 8, 2001.

Additionally, the rules do not give Public Law 103-465 (URAA) a retroactive force and a discriminatory force. Petitioner argues that there is no mention in PL 103-465 that a continuation application could change the term of a patent issued from an original application filed before June 8, 1995.

Suspension of the rules is not warranted. The consequences of patentees' action in filing a CPA is that the patent issued on

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<sup>2</sup> Petition granted to accord filing date of August 16, 2001.

January 14, 2003 would have a term of 20 years from the date of filing of the application, March 8, 1991 (earliest filing application under 365(c)). Petitioner was so advised by the Office. Petitioner had the alternative of filing an RCE. Petitioner articulated no reasons why he should not have been aware of this distinction.

The receipt of the petition fee of \$130 for consideration under § 1.183 is acknowledged.

The application is being forwarded to the Certificate of Corrections Branch for consideration of the request for certificate of correction filed March 26, 2003.

Telephone inquiries with regard to this communication should be directed to Petitions Attorney Nancy Johnson at (571) 272-3219.

*Kery A. Fries*

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